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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/820,526 | 04/07/2004 | Andrew Valdez | | 8335 |
| 7590 | 01/10/2005 | | EXAMINER | |
| Donald W. Meeker Patent Agent 924 East Ocean Front #E Newport Beach, CA 92661 | | | ABDELWAHED, ALI F | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3722 | |

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/820,526 | VALDEZ, ANDREW | |
| | Examiner | Art Unit | |
| | Ali Abdelwahed | 3722 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Objections

Claims 1 and 3-5 are objected to because of the following informalities:

It is suggested that in:

Claim 1, lines 6, 9, 11, 12, and 15, before "...door..." delete "a" and insert --the--.

Claim 1, line 10, after "...holes on..." delete "a" and insert --the--.

Claim 1, lines 11-13, before "...edge of..." delete "an" and insert --the--.

Claim 1, lines 12 and 13, after "...edge of..." delete "a" and insert --the--.

Claims 3-5, line 3, before "...door..." delete "a" and insert --the--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the fixture holes" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim(s) 2-6 depend from rejected claim(s) 1 and include all of the limitations of claim(s) 1 thereby rendering these dependent claim(s) indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,114,285 to Brydon in view of U.S. Patent Application Publication No. 2004/0020809 A1 to Allan et al.

Brydon discloses a door drilling template (10) comprising a square U shaped three sided channel having two opposing parallel spaced mating sides (50, 60) and an interconnecting top (70) orthogonal to both sides (see fig.1). The template is fabricated of rigid material, such as plastic (see Abstract lines 1-2, and column 3, lines 17-20). The template has at least one mating configuration of spaced pencil-point-size marking holes (80) on both opposing sides of the channel (see fig.1). Each of the at least one configuration of holes corresponding to a configuration of screw holes in a door mounted fixture, such as a door closer, lock fixture, or knob fixture that are to be attached to the door by screw-type attaching means (see column 1, lines 47-51). The template is adapted for straddling the edge of the door with the two opposing sides

positioned over a portion of a front and back side of a door and the top over an edge of a door (see fig. 4).

However, Brydon fails to teach the template device being sufficiently thin (or ultra-thin) to fit between an edge of a door and a door frame when the door is closed. Nevertheless, Allan et al. teaches a template device (4, 24) that is sufficiently thin to fit between an edge of a door and a door frame when the door is closed (see figs. 2, 9).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the template of Brydon, in view of Allan et al., such that it would provide the template of Brydon with the concept of being sufficiently thin to fit between an edge of a door and a door frame when the door is closed for the purpose of utilizing the device when the door is in an open or closed position with respect to the door frame and to also provide accurate alignment with mating elements on the door frame.

Furthermore, given that the Brydon reference discloses all of the claimed structural limitations of the above claims, the Brydon reference therefore is assumed to be capable of performing all of the claimed functions of the above claims. It has been held that the recitation that an element is "adapted to/capable of" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brydon in view of Allan et al. as applied to claim 1 above, and further in view of U.S. Patent No. 5,058,285 to Morita et al.

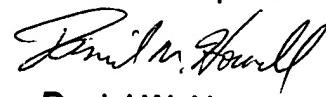
Brydon, as modified, discloses the claimed invention except for the template further comprising a line visible on each side of the template interconnecting each of the configurations of holes, thereby distinguishing each configuration of holes from another. However, Morita et al. teaches a template device (1) comprising a line (6, 7) visible on each side of the template interconnecting each of the configurations of holes (see fig.1a, and columns 2 and 3, lines 61-64 and 15-17). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the template of Brydon, as per the teachings of Morita et al., such that it would provide the template of Brydon with the concept of having a line visible on each side of the template interconnecting each of the configurations of holes for the purpose of distinguishing one configuration of holes from another configuration of holes.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Abdelwahed whose telephone number is (571) 272-4417. The examiner can normally be reached Monday through Friday from 10:00 A.M. to 6:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on (571) 272-4483.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the examiner or the examiner's supervisor.



Daniel W. Howell
Primary Examiner
Art Unit 3722

AA
01/03/2005